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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,057	07/31/2000	David William Geen	95-444	5171

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LEON R TURKEVICH
2000 M STREET NW
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER

NGUYEN, VAN KIM T

ART UNIT PAPER NUMBER

2151

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,057

Applicant(s)

GEEN ET AL.

Examiner

Van Kim T. Nguyen

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16, 17, 23, 29 and 44 is/are rejected.
- 7) ☒ Claim(s) 2-15, 18-22, 24-28, 30-43, and 45-58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to communications filed on February 18, 2005.

Applicant's arguments with respect to claims 1, 16, 17, 23, 29, and 44 have been fully considered but they are not persuasive. See below for further explanations.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 16, 17, 23, 29, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al (US 6,731,734), hereinafter Shaffer.

As shown in Figures 1-9, Shaffer discloses a communication method in a media server (112), comprising: establishing a call (multipoint conference call) having a first media channel with an IP telephony gateway, the first media channel configured for transmitting a first media stream (connection in which each endpoints utilizes its respective codec) according to a corresponding first compression (endpoint's respective codec; initiating closing of the first media channel (step 816; col. 5: lines 30-34) based on a request for a resource utilizing a second compression (steps 810-814, col. 5: lines 24-30); and starting for the call (the same multipoint conference call, step 818-820., col. 5: lines 34-37) a second media channel, configured for transmitting a second media stream (new connection with new codec, step 822; col. 5: lines 37-41) according to the second compression (new codec), upon closing the first media channel.

Allowable Subject Matter

3. Claims 2-15, 18-22, 24-28, 30-43, and 45-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant argues, and the Examiner respectfully agrees, interpreting the claims in light of the present specification requires:

- (1) the second media stream must clearly be different than the first media stream,
- (2) the second media stream must be transmitted at a different compression than the first media stream, and
- (3) the first and second media streams must be transmitted on the same call.

As shown above, Shaffer teaches:

- (1) the second media stream (new connection) is clearly different than the first media stream (old connection).
- (2) the second media stream transmits at a different compression (codec) than the first media stream, and
- (3) the first and second media streams are transmitted on the same call (the conference call).

Art Unit: 2151

It is noted that though Shaffer does not explicitly disclose transmitting different media streams on the same media channel, inherently the media channel (physical medium) remains the same since there is not a change in transmission medium.

In response to applicant's argument that "Shaffer only teaches closing and opening new media channels" and "The continuous changing of channels and codecs during a single conference call cannot be equated with changing media streams having different codecs", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Thus since Shaffer teaches utilizing new connection (second media stream) having a corresponding new compression, upon dropping the old connection (first media stream) having a corresponding old compression during a call, it meets the claims.

Similarly, since Shaffer clearly disclose "initiating closing of the first media channel" and "starting for the call a second media channel"; e.g., "*the relevant user sends a call setup command which received by the MCU 104's MC 112. The MC 112 recognizes the call setup command, ..., in a step 818, undertakes the appropriate H.323 call control an signaling commands to setup the new connection using the new codec.*", col. 5: lines 30-41.

Art Unit: 2151

Inherently whence the relevant user sends a call setup command, the relevant user is initiating the closure of the first *logical* media channel, and starting for the same call a second *logical* media channel, which may or may not be the same, configured for transmitting a second media streams according to a second compression.

In response to applicant's arguments that "*Shaffer does not disclose that the first and second media channels of the call are established by a media server, but rather by multipoint control unit (MCU) 122*", page 3: lines 27-29, the recitation a media server has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*the new connection must be initiated by the user H.323 endpoint 102, and not by the MCU 104*", page 4: lines 7-8) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2151

In response to applicant's argument that "*Shaffer does not disclose or even suggest 'starting for the call a second media channel ... upon closing of the first media channel'*", page 4: lines 4-5). As described above, Shaffer discloses "*the relevant user sends a call setup command which received by the MCU 104's MC 112. The MC 112 recognizes the call setup command, ..., in a step 818, undertakes the appropriate H.323 call control an signaling commands to setup the new connection using the new codec.*", col. 5: lines 30-41.

Inherently whence the relevant user sends a call setup command, the relevant user initiates the closure of the first *logical* media channel, and starts for the same call a second *logical* media channel, which may or may not be the same, configured for transmitting a second media streams according to a second compression. The act of setting up a new media stream, inherently, happens upon changing the first media channel to the second media channel, within the same conference call.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 2151

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Van Kim T. Nguyen whose telephone number is 571-272-3073. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Van Kim T. Nguyen
Examiner
Art Unit 2151

vkkn



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER